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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/683,967	10/10/2003	Sheri Lynn Baker	CFLAY.00197	1851

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EXAMINER	
KUHNS, SARAH LOUISE	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/683,967	BAKER ET AL.	
	Examiner	Art Unit	
	Sarah L Kuhns	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-43* is/are pending in the application.

4a) Of the above claim(s) *7-16 and 27-42* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,17-26 and 43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6, 17-26, and 43, drawn to a toasted corn regrind and methods of making it, classified in class 426, subclass 622.

II. Claims 7-16 and 27-41, drawn to a masa mixture, corn chips, and a method of making each, classified in class 426, subclass 496.

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because higher than normal ash content is not required. The subcombination has separate utility such as a coating and/or filling material for meats and other foods.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with William Wang on January 6th, 2005, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6, 17-26, and 43. Affirmation of this election must be made by applicant in

replying to this Office action. Claims 7-16 and 27-42 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. A number of factors must be considered in assessing the enablement of an invention, including the following: the breadth of the claims, the amount of experimentation necessary, the guidance provided in the specification, working examples provided, predictability, and the state of the art. See *In re Wands*, 858 F.2d 731, 8 USPQ2nd 1400 (Fed. Circ. 1988). This claim recites corn chip regrind having "an ash content that is higher than the normally found in consumable corn chips." The specification does not provide guidance as to what "normal" ash content is and one of ordinary skill in the art would not know exactly what applicant means to include with this language.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear as to what is included by the language "higher than normally found in consumable corn chips."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by "Salmon Patties." "Salmon Patties" discloses a toasted flavor additive comprising a plurality of ground particles of a toasted product, wherein the toasted product comprises corn chips (page 3). "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Salmon Patties" in view of Ellis et al., U.S. Patent 4,806,37.

In regard to claims 1, 4, and 5, "Salmon Patties" discloses a recipe that calls for the grinding of corn chips (page 3) and the addition of the regrind to food. "Salmon Patties" does not disclose the moisture content or the oil content of the corn chips. Ellis discloses corn chips with a moisture content of less than 2% by weight (column 3, lines 47-50) and an oil content of 2-30% by weight (column 2, lines 34-39). "Salmon Patties" suggests the use of Fritos, but it is expected that any corn chips would suffice and therefore, it would be obvious to use the corn chips of Ellis to make the regrind used in

"Salmon Patties." Absent a showing to the contrary by clear and convincing evidence, and because it is not clear from applicant's disclosure as to what is the exact ash content applicant means to claim, it would be expected that the crushed corn chips of "Salmon Patties" have the same increased ash content as that claimed.

In regard to claim 6, "Salmon Patties" does not disclose the L-value of the crushed corn chips. However, it would have been expected for the corn chips of "Salmon Patties" to have an L-value less than that of dry masa dough, as claimed by applicant, since the corn chips of "Salmon Patties" are made by toasting and frying masa dough and both of these processes are known to make foods darker which in turn decreases the L-value.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of "Salmon Patties" in view of Ellis et al., U.S. Patent 4,806,37, as applied to claim 1, 4, 5, and 6 above, in further view of "A Dinner Experiment" and "Dried Food Products." "Salmon Patties" does not disclose the size of the ground corn chip particles. However, "A Dinner Experiment" discloses the placing of corn chips in food processor and chopping them until very fine (page 8) and it is expected that once chopped, the particles would be within the sizes claimed by applicant. Additionally, other food additives, such as garlic granules, are sold with particles sizes within the ranges claimed by applicant, as evidenced by "Dried Food Products," and as such, it would be obvious to chop the corn chips until the particle sizes were between 26 and 40 mesh.

Claims 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Food Product Design" in view of "Salmon Patties" and Ellis et al.

In regard to claims 17-25, methods of making corn chips were well known to one of ordinary skill in the art, as evidenced by "Food Product Design" (page 3). "Food Product Design" discloses the cooking of a plurality of whole corn kernels in a solution of water and lime, steeping the kernels in the solution, draining the solution from the kernels and washing the kernels to form a fresh masa dough and then sheeting the masa dough, cutting the dough, and toasting the dough to remove excess moisture (page 3). "Food Product Design" further discloses the frying of the toasted flavor pieces after toasting in a triple-pass gas-fired oven, which utilizes both convective heat and infrared radiation (page 3). "Food Product Design" does not disclose the moisture content or oil content of the chips and also does not disclose the grinding of the chips. However, Ellis discloses corn chips with a moisture content of less than 2% by weight (column 3, lines 47-50) and an oil content of 2-30% by weight (column 2, lines 34-39) and it would therefore have been obvious to use the method of "Food Product Design" to make chips with low moisture and oil content as taught by Ellis in order to provide chips with reduced fat content. "Salmon Patties" discloses the grinding of corn chips (page 3) for use as filling material in a food product. It therefore would have been obvious to grind the corn chips made by the method of "Food Product Design" for use as a coating or filler with food products. "Food Product Design" does not disclose the L-value of the crushed corn chips. However, absent a showing of clear and convincing evidence to the contrary, it is expected that corn chips in general are darker than dry

masa dough since they are made from masa dough that is toasted and fried and both of these processes are known to make foods darker.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah L Kuhns whose telephone number is 571-272-1088. The examiner can normally be reached on Monday - Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLK

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